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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/517,126

03/08/2006

Gerd Schmaucks

E-1048

2783

20311 7590 12/30/2008
LUCAS & MERCANTI, LLP
475 PARK AVENUE SOUTH
15TH FLOOR
NEW YORK, NY 10016

EXAMINER

LACLAIR, DARCY D

ART UNIT

PAPER NUMBER

1796

MAIL DATE

DELIVERY MODE

12/30/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Attachment to Advisory Action

Applicants' amendment filed 12/15/2008 has been fully considered; however, the amendment has not been entered given that it raises issues of new matter.

With respect to issues of new matter (and thus new issues), Claim 8 has been amended to recite a filler content of "about 5%" by weight of the resin. While 5% by weight is fully supported in the original claims, "about 5%" is not supported. It is the examiner's position that this phrase fails to satisfy the written description requirement of 35 USC 112, first paragraph since there does not appear to be a written description requirement of the phrase "about 5%" in the application as originally filed, *In re Wright*, 866 F.2d 422, 9 USPQ2d 1649 (Fed. Cir. 1989) and MPEP 2163. Applicant has not pointed to any portion of the specification, and examiner has not found any support for this phraseology in the specification as originally filed.

In the interest of better enabling the applicants to assess the patentability of their claims, the following advisory is given:

Had the amendment been entered, the new matter rejection of claims 1, 4, 7 and 8, regarding 15% and 500% by weight, would have been overcome. The prior art rejections over Mitsuhashi et al. would have been maintained. Applicant has argued (A) the specification teaches specific size, density, and surface area characteristics for the microsilica which are not found in Mitsuhashi, and (B) Mitsuhashi teaches in paragraph [0012] that the silicon rubber was formed in one step of furnace heating all of the composition, without performing any highly filled elastomeric compound first, and

Art Unit: 1796

Mitsubishi does not specify a step of adding microsilica to modify the processability of the compound.

With regard to argument (A), the silica powder of Mitsubishi is less than 50 μm . This is a micron sized silica particle, or microsilica. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., size, density, and surface area) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

With respect to argument (B), Mitsubishi discloses that one effect of the invention is workability. (see par [0016]) Furthermore Mitsubishi teaches that the composition can be obtained by mixing in a predetermined quantity of the components (a) to (g). (See par [0009]) It would be obvious to adjust the order in which the components are mixed. *Ex parte Rubin*, 128 USPQ 440 (Bd. App. 1959) (Prior art reference disclosing a process of making a laminated sheet wherein a base sheet is first coated with a metallic film and thereafter impregnated with a thermosetting material was held to render prima facie obvious claims directed to a process of making a laminated sheet by reversing the order of the prior art process steps.). See also *In re Burhans*, 154 F.2d 690, 69 USPQ 330 (CCPA 1946) (selection of any order of performing process steps is prima facie obvious in the absence of new or unexpected results); *In re Gibson*, 39 F.2d 975, 5 USPQ 230 (CCPA 1930) (Selection of any order of mixing ingredients is prima facie obvious.).

Application/Control Number: 10/517,126
Art Unit: 1796

Page 4

12/22/2008

/D. L/

Examiner, Art Unit 1796

/Vasu Jagannathan/
Supervisory Patent Examiner, Art Unit 1796